

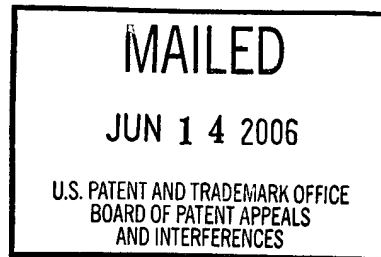
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NAMON A. NASSEF

Application No. 10/603,336



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on May 11, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing is identified below.

A review of the file indicates that on September 22, 2005, appellant filed an Appeal Brief that was not in full compliance with the new rules set forth in 37 CFR § 41.37(c) effective September 13, 2004.

37 CFR § 41.37(c) states:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(i) *Real party in interest.* A statement identifying by name the real party in interest.

(ii) *Related appeals and interferences.* A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(x) of this section.

(iii) *Status of claims.* A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

(iv) *Status of amendments.* A statement of the status of any amendment filed subsequent to final rejection.

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each claim involved in the appeal, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(vii) *Argument*. The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for patentability of the claim.

(viii) *Claims appendix*. An appendix containing a copy of the claims involved in the appeal.

(ix) *Evidence appendix*. An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix*. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

A review of the application reveals that the following sections are again missing from the second corrected Appeal Brief:

(1) "Grounds of rejection to be reviewed on appeal," as stated in 37 CFR § 41.37(c)(1)(vi). It is required that a substitute Appeal Brief be submitted that is in compliance with the new rules under 37 CFR § 41.37(a);

(2) "Evidence appendix," as stated in 37 CFR § 41.37(c)(1)(ix); and

(3) "Related proceedings appendix," as stated in 37 CFR § 41.37(c)(1)(x).

Accordingly, the Appeal Brief mailed on September 20, 2005 does not comply with the new rules under 37 CFR § 41.37(c). It is required that a substituted Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(a).

Upon review of the Examiner's Answer mailed December 20, 2005, the examiner states under the heading "Evidence Relied Upon," "[n]o evidence is relied upon by the examiner in the rejection of the claims under appeal." However, under the heading "Grounds of Rejection," the examiner clearly references three U.S. Patents, e.g., U.S. 6,581,322 (Spinelli); U.S. 5,720,124 (Wentzell) and U.S. 4,685,242 (Stanish). This seems to be a discrepancy on the part of the examiner. Clarification is required regarding these three "U.S. Patents. See MPEP § 1207.02.

Accordingly, it is

ORDERED that the application is returned to the examiner to:

- 1) hold the Amended Appeal Brief of September 22, 2005 defective;
- 2) notify appellant to file a substitute brief in full compliance with 37 CFR § 41.37(a);

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- 3) have the substituted Appeal Brief scanned into the electronic file; and
- 4) to submit a revised Examiner's Answer to include all the prior art applied in the Examiner Answer under the heading "Evidence Relied Upon," and,
- (5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES



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